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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213092
Party	Defendant Chaban Wellness LLC
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Date	02/05/2014
Attachments	Response to Motion to Dismiss or Strike - Final.pdf(137187 bytes ) Exhibit A - Amended Counterclaim - final.pdf(1265294 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In re U.S. Trademark Applications Serial No. 85/769870 (for YES YOU CAN! in International Class 44; filed November 2, 2012); Serial No. 85/769864 (for YES YOU CAN! in International Class 41); and 85/769860 (for YES YOU CAN! in International Class 5; filed November 2, 2012)*

DR. MATTHIAS RATH,  
  
Opposer,

**Opposition No.: 91213088**  
**Opposition No.: 91213090; and**  
**Opposition No.: 91213092**

v.

CHABAN WELLNESS LLC  
  
Applicant.

**APPLICANT’S RESPONSE TO OPPOSER’S MOTION TO DISMISS APPLICANT’S  
COUNTERCLAIMS AND TO STRIKE OR DISMISS APPLICANT’S AFFIRMATIVE  
DEFENSES PURSUANT TO FED.R.CIV.P. 12(b)(1), 12(b)(6), AND 12(f)**

Applicant, CHABAN WELLNESS LLC (“CW”), hereby responds to Opposer’s Motion to Dismiss Applicant’s Counterclaims and to Strike or Dismiss Applicant’s Affirmative Defenses Pursuant to Fed.R.Civ.P. 12(b)(1), 12(b)(6), and 12(f), and states as follows:

1. On December 2, 2013, CW filed and served its Answers, Affirmative Defenses and Counterclaims in response to the Opposer, Matthias Rath’s (“Rath”), Notices of Opposition in the above referenced proceedings.<sup>1</sup>

2. On January 21, 2014, the Opposer, Matthias Rath (“Rath”), filed and served his Motions to Dismiss Applicant’s Counterclaims and to Strike or Dismiss Applicant’s Affirmative Defenses Pursuant to Fed.R.Civ.P. 12(b)(1), 12(b)(6), and 12(f) (hereinafter, “Motions to Dismiss and/or Strike”).

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<sup>1</sup> On January 30, 2014, Rath filed a Motion to Consolidate the three above-referenced Opposition proceedings. The Applicant, CW, has consented to the requested consolidation.

3. CW's response to Rath's Motions to Dismiss and/or Strike is due today, Wednesday February 5, 2014.

4. Nevertheless, pursuant to Rule 15(a)(1) of the Federal Rules of Civil Procedure, CW is permitted to amend its Counterclaims as a matter of right (without leave or the Opposer's consent) within twenty-one (21) days following Rath's filing and service of his Motions to Dismiss and/or Strike. In other words, under the Rules, CW may amend its Counterclaim without leave or the Opposer's consent at any time on or before Tuesday, February 11, 2014.

5. Opposer's primary basis for its Motions to Dismiss and/or Strike, under Rule 12(b)(6), consists of an argument that the Applicant's affirmative defenses and counterclaims lack sufficient specificity.

6. Accordingly, rather than waste the parties' time arguing, and the TTAB's time considering and determining, whether or not there is currently enough specificity in CW's affirmative defenses and counterclaims, CW simply desires to amend its counterclaim and affirmative defenses to add further specific allegations. Additionally, CW desires to clarify a Paragraph 4 of its Answer.

7. Because CW's original answer, affirmative defenses and counterclaims were all contained within one document, CW intends to be consistent therewith and file and serve one document containing all of the amended pleadings.

8. Although, CW may amend its counterclaims as of right under Rule 15(a)(1), it has nevertheless, out of caution, respect for the Rules and courtesy to the Opposer, telephoned and e-mailed the Opposer's counsel in order to confer and obtain Opposer's consent to CW's filing of an amendment to CW's answer and affirmative defenses. During a telephone conversation on the afternoon of February 5, 2014, Opposer's counsel, John Blattner, indicated that the Opposer

consents to Applicant's filing of amendments to its answer and affirmative defenses in response to Opposer's Motions to Dismiss and/or Strike.

**WHEREFORE**, Applicant CHABAN WELLNESS LLC prays that this Board deny Opposer's Motion to Dismiss Applicant's Counterclaims and to Strike or Dismiss Applicant's Affirmative Defenses Pursuant to Fed.R.Civ.P. 12(b)(1), 12(b)(6), and 12(f), and further prays that this Board deem the Applicant's Amended Answers, Affirmative Defenses and Counterclaims, which are attached hereto as Exhibit "A", as filed in these proceedings.

Dated: February 5, 2014

Respectfully submitted,

/s/ Susan J. Latham

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*Attorneys for Applicant Chaban Wellness LLC*

**CERTIFICATE OF MAIL AND CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that, on February 5, 2014, this paper is being electronically filed via the Electronic System for Trademark Trial and Appeals. I also hereby certify that a true copy of the foregoing document was served on counsel for the Opposer by delivering the same via electronic mail (e-mail) to [jblattner@dickinsonwright.com](mailto:jblattner@dickinsonwright.com); [apelker@dickinsonwright.com](mailto:apelker@dickinsonwright.com), and by also delivering it via first class U.S. mail, postage prepaid, to: John C. Blattner, DICKINSON WRIGHT PLLC, 350 S. Main Street, Suite 300, Ann Arbor, Michigan 48104.

/s Susan J. Latham  
SUSAN J. LATHAM

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In re U.S. Trademark Applications Serial No. 85/769870 (for YES YOU CAN! in International Class 44; filed November 2, 2012); Serial No. 85/769864 (for YES YOU CAN! in International Class 41); and 85/769860 (for YES YOU CAN! in International Class 5; filed November 2, 2012)*

DR. MATTHIAS RATH,  
  
Opposer,

**Opposition No.: 91213088**  
**Opposition No.: 91213090; and**  
**Opposition No.: 91213092**

v.

CHABAN WELLNESS LLC  
  
Applicant.

**APPLICANT’S AMENDED ANSWER, AFFIRMATIVE DEFENSES,  
AND COUNTERCLAIM TO MATTHIAS RATH’S NOTICES OF OPPOSITION**

Applicant, CHABAN WELLNESS LLC, hereby respectfully sets forth its amended answers and affirmative defenses to Opposer’s, DR. MATTHIAS RATH’s, Notice of Opposition (“Opposition”) and states as follows:

1. Applicant admits that it is a Florida limited liability company and is domiciled in the State of Florida, having an office in Coral Gables, Florida.
2. Applicant admits that on or about November 2, 2012, it caused to be filed an application with the United States Patent and Trademark Office (“USPTO”), having a Serial No. 85/769870 (“the ‘870 Application”), for the standard character trademark YES YOU CAN! for use in connection with goods in International Class 44, including “Consultation in the fields of wellness, diet, nutrition, weight loss, health, mental health, and well-being; providing a website featuring information in the fields of wellness, diet, nutrition, weight loss, health, mental

health, and well-being; information services concerning wellness, diet, nutrition, weight loss, health, mental health, and well-being for wireless and mobile devices; providing information via a global computer network in the fields of wellness, diet, nutrition, weight loss, health, mental health, and well-being; providing interactive online databases via a global computer network for creating personalized and customized wellness, diet, nutrition, weight loss, health, mental health, and well-being programs; providing consultation and information via a global computer network in the fields of wellness, diet, nutrition, weight loss, health, mental health, and well-being; providing online information related to the planning of diet, nutrition, weight loss, and mental health programs; preventative health care information.”

3. Applicant is without sufficient knowledge as to the allegations in Paragraph 3 of the Opposition and, therefore, denies same.

4. Applicant’s initial research of the USPTO database shows no record of Reg. No. 2,863,920 covering Class 44 as indicated by Opposer in the last sentence of Paragraph 4 of its Opposition and, therefore, Applicant denies that Reg. No. 2863920 covers Class 44. Applicant is without sufficient knowledge as to all remaining allegations in Paragraph 4 of the Opposition and, therefore, denies same.

5. Applicant admits that the Opposer has not expressly authorized Applicant to use or apply to register the mark shown in the ‘870 Application. However, Applicant denies that any such authorization was required, and Applicant denies all remaining allegations in Paragraph 5 of the Opposition.

6. Applicant denies the allegations in Paragraph 6 of the Opposition.

7. Applicant denies the allegations in Paragraph 7 of the Opposition.

8. Applicant denies any and all allegations in the Opposition that have not been responded to or specifically admitted.

9. WHEREFORE, Applicant denies that the Opposer is entitled to the relief he requests through his Prayer for Relief.

## **AMENDED AFFIRMATIVE DEFENSES**

### **FIRST AFFIRMATIVE DEFENSE**

*Fraud Upon United States Patent and Trademark Office regarding Registration Nos. 2,863,920.*

After a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that the Opposer committed fraud upon the USPTO with regard to maintaining its Registration No. 2,863,920 through knowing and material misrepresentations as to the use (or lack thereof) of the purported YOU CAN! mark. It appears that the Opposer never used the YOU CAN! mark between the date of registration (July 20, 2004) and the date his initial Section 8 Declaration of Use or Excusable Nonuse was due (July 20, 2010).<sup>1</sup> It further appears that if the Opposer made any use of the YOU CAN! mark, it was not until the expiration of the grace period for filing his initial Section 8 Declaration of Use or Excusable Nonuse (January 20, 2011). Indeed, Opposer has admitted that the first use of a YOU CAN mark without regard to stylistic features was not until January 20, 2011. Moreover, on March 7, 2010, the USPTO cancelled the Opposer's previous registration (Registration No. 2,745,578) for the YOU CAN mark in the same international classes at the Registrations he asserts in these proceedings because Opposer failed to file a

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<sup>1</sup> The Opposer's German trademark registration (No. 39959414) upon which the U.S. Registration No. 2,863,920 was based was cancelled on October 1, 2009 as a result of Matthias Rath's failure to renew it.



## Section 8 Declaration of Use.<sup>2</sup>

Moreover, it appears that the use of YOU CAN! that the Opposer asserted as of January 20, 2011 was merely token use and was not use in a trademark sense. For example, with regard to International Class 5 (for nutritional supplements; dietary supplements; vitamin and mineral supplements), the specimen that Opposer submitted with his Section 8 Declaration of Use was not a printout from a webpage associated with the “Product” tab/pages of <http://drrathvitamins.com> website but, rather, merely a printout of a webpage associated with the “Contact” tab of such website, displaying contact information. According to public archives, the actual “Product” pages of the Opposer’s website, which informed consumers of the particular goods being offered, did not contain the purported YOU CAN! mark.

Furthermore, the Opposer impermissibly registered the YOU CAN! mark for goods and services between which there is no material difference in the kind of economic activity being conducted. In other words, there is not a sufficient separation between the goods and services allegedly offered and registered under the ‘920 Registration. For example, in Class 16, the Opposer registered YOU CAN! for “newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements”, while also contemporaneously registering YOU CAN! in Class 42 for “providing health information, namely, information in the field of healthcare and nutritional supplements, dietary supplements, vitamin and mineral supplements.” Similarly, in Class 41, the Opposer registered YOU CAN! for “distributing course material” whereas in Class 16, the Opposer registered YOU CAN! for “educational materials.”

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<sup>2</sup> The Opposer’s German trademark registration (No. 39959413) upon which the U.S. Registration No. 2,745,578 was based was cancelled on October 1, 2009 as a result of Matthias Rath’s failure to renew it.

## SECOND AFFIRMATIVE DEFENSE

*Opposer's Registration No. 3,967,892 was Void at Inception.*

After a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that the Opposer's Registration No. 3,967,892 for the purported YOU CAN mark was void ab initio and, thus, was never entitled to registration on the Principal Register and, consequently, should be cancelled therefrom. The mark registered under Registration No. 3,967,892 is, in all material respects and commercial impression, the same as a mark the Opposer first registered under the cancelled Registration No. 2,745,578 which covered the same international classes as those covered under Registration No. 3,967,892. The mark registered under Registration No. 3,967,892 is also the same, in all material respects and commercial impression, as the mark registered under Registration No. 2,863,920. Accordingly, Registration No. 3,967,892 is an improper duplication two previously registered marks.

Moreover, Opposer stated that his first use of the YOU CAN mark without regard to stylistic features was on January 20, 2011. However, it appears that the use of the purported YOU CAN mark that the Opposer asserted was merely token use and was not use in a trademark sense. For example, the specimen that Opposer submitted on March 29, 2011 with his Statement of Use pertaining to International Class 5 (for nutritional supplements; dietary supplements; vitamin and mineral supplements) was not a printout from a webpage associated with the "Product" tab/pages of <http://drrathvitamins.com> website but, rather, merely a printout of a webpage associated with the "Contact" tab of such website, displaying contact information. According to public archives, the actual "Product" pages of the Opposer's website, which informed consumers of the particular goods being offered, did not contain the purported YOU CAN mark.

Furthermore, the Opposer impermissibly registered the YOU CAN mark for goods and services between which there is no material difference in the kind of economic activity being conducted. In other words, there is not a sufficient separation between the goods and services allegedly offered and registered under the '892 Registration. For example, in Class 16, the Opposer registered YOU CAN for "newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements", while also contemporaneously registering YOU CAN in Class 44 for "providing health information, namely, information in the field of healthcare and nutritional supplements, dietary supplements, vitamin and mineral supplements." Similarly, in Class 41, the Opposer registered YOU CAN for "distributing course material" whereas in Class 16, the Opposer registered YOU CAN for "educational materials."

### THIRD AFFIRMATIVE DEFENSE

*Fraud Upon United States Patent and Trademark Office regarding Registration No. 3,967,892.*

After a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that the Opposer committed fraud upon the USPTO with regard to obtaining its Registration No. 3,967,892 through knowing and material misrepresentations as to the purported YOU CAN mark. The mark registered under Registration No. 3,967,892 is, in all material respects and commercial impression, the same as the mark first registered under the cancelled Registration No. 2,745,578 which covered the same international classes as those covered under Registration No. 3,967,892. The mark registered under Registration No. 3,967,892 is also the same, in all material respects and commercial impression, as the mark registered under Registration No. 2,863,920. Accordingly, Registration No. 3,967,892 is an improper duplication two previously registered marks.

Moreover, Opposer stated that his first use of the YOU CAN mark without regard to

stylistic features was on January 20, 2011. However, it appears that the use of the purported YOU CAN mark that the Opposer asserted was merely token use and was not use in a trademark sense. For example, the specimen that Opposer submitted on March 29, 2011 with his Statement of Use pertaining to International Class 5 (for nutritional supplements; dietary supplements; vitamin and mineral supplements) was not a printout from a webpage associated with the “Product” tab/pages of <http://drrathvitamins.com> website but, rather, merely a printout of a webpage associated with the “Contact” tab of such website, displaying contact information. According to public archives, the actual “Product” pages of the Opposer’s website, which informed consumers of the particular goods being offered, did not contain the purported YOU CAN mark.

Furthermore, the Opposer impermissibly registered the YOU CAN mark for goods and services between which there is no material difference in the kind of economic activity being conducted. In other words, there is not a sufficient separation between the goods and services allegedly offered and registered under Registration No. 3,967,892. For example, in Class 16, the Opposer registered YOU CAN for “newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements”, while also contemporaneously registering YOU CAN in Class 44 for “providing health information, namely, information in the field of healthcare and nutritional supplements, dietary supplements, vitamin and mineral supplements.” Similarly, in Class 41, the Opposer registered YOU CAN for “distributing course material” whereas in Class 16, the Opposer registered YOU CAN for “educational materials.”

#### FOURTH AFFIRMATIVE DEFENSE

##### *Abandonment of Registration No. 2,863,920.*

After a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that the Opposer abandoned the YOU CAN! mark registered under Registration No. 2,863,920. It appears that the Opposer made no use of the YOU CAN! mark in connection with any goods or services for more than five consecutive years from the date of issuance of Registration No. 2,863,920 (July 20, 2004) and not until at least the end of the six-month grace period for filing its Affidavit under Section 8 of the Lanham Act (January 20, 2011). The documents publicly available further support a reasonable belief that the Opposer filed his Section 8 Declaration of Use on the last day of the grace period (January 20, 2011) using an improper specimen of use and for the improper purpose of reserving an otherwise invalid trademark upon the Principal Register. However, due to the Opposer's failure to use the YOU CAN! mark within a reasonable time following registration, that mark had become and is abandoned for purposes of Section 45 of the Trademark Act.

#### FIFTH AFFIRMATIVE DEFENSE

##### *Estoppel / No Likelihood of Confusion.*

Opposer is stopped from taking the position that there is a likelihood of confusion between CW's "YES YOU CAN!" marks and Rath's "YOU CAN" or "YOU CAN!" marks because Opposer has previously taken a contrary position before the USPTO, within his October 17, 2000 response to an Office Action regarding application Serial No. 75/862043, wherein the USPTO's examiner had cited the mark "NOW YOU CAN" against Rath's application. Rath successfully obtained registration of his "YOU CAN" and "YOU CAN!" marks based on his position that the cited "NOW YOU CAN" mark possessed an additional term in its mark which is positioned at the very beginning of its mark, creating significant differences between the

appearance and sound of the respective marks.” Rath further argued that: “In compound marks, the first word is generally more prominent to the eye and to the ear.” Having been successful in that position with regard to the registration of his marks, Rath cannot change that position now.

#### SIXTH AFFIRMATIVE DEFENSE

##### *Improper Specimens of Use for Registration No.s 2,863,920 and 3,967,892.*

After a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that the Opposer knowingly filed improper specimens of use as to some or all of the goods and/or services associated with the YOU CAN! and YOU CAN trademark registrations and, therefore, knowingly mislead the United States Patent and Trademark Office into issuing and/or allowing the Opposer to maintain Registration No. 2,863,920 and Registration No. 3,967,892 upon the Principal Register.

It appears that the use of the purported YOU CAN and YOU CAN! marks that the Opposer asserted was merely token use and not use in a trademark sense. For example, with regard to International Class 5 (for nutritional supplements; dietary supplements; vitamin and mineral supplements), the specimen that Opposer submitted was not a printout from a webpage associated with the “Product” tab/pages of <http://drrathvitamins.com> website but, rather, merely a printout of a webpage associated with the “Contact” tab of such website, displaying contact information. According to public archives, the actual “Product” pages of the Opposer’s website, which informed consumers of the particular goods being offered, did not contain the purported YOU CAN mark.

Furthermore, the Opposer impermissibly registered the YOU CAN mark for goods and services between which there is no material difference in the kind of economic activity being conducted. In other words, there is not a sufficient separation between the goods and services allegedly offered and registered. For example, in Class 16, the Opposer registered the marks for

“newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements”, while also contemporaneously registering the marks in Class 42 and 44 for “providing health information, namely, information in the field of healthcare and nutritional supplements, dietary supplements, vitamin and mineral supplements.” Similarly, in Class 41, the Opposer registered the mark for “distributing course material” whereas in Class 16, the Opposer registered it for “educational materials.”

#### SEVENTH AFFIRMATIVE DEFENSE

##### *Unclean Hands.*

After a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that the Opposer has improperly obtained and/or maintained its Registration No.s 2,863,920 and 3,967,892 and, therefore, is coming into this proceeding with unclean hands in so far as it is asserting and attempting to enforce rights it does not actually possess.

#### EIGHTH AFFIRMATIVE DEFENSE

##### *Opposer Lacks a Protectable Trademark Due to Naked Licensing.*

Even if the Opposer had at one time possessed valid trademark registrations under Registration No. 2,863,920 and Registration No. 3,967,892, upon information and belief, the Opposer has involuntarily abandoned and/or lost its trademark rights with respect to those marks through uncontrolled licensing (“naked licensing”) of its alleged trademarks—*i.e.*, through the failure to exercise control over its licensees’ use of the alleged trademark.

### NINTH AFFIRMATIVE DEFENSE

#### *Unlawful Use in Commerce / Unclean Hands.*

After a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that the Opposer is using the marks associated with Registration No.s 2,863,920 and 3,967,892 to mislead consumers into believing that the goods and services being sold in connection with the YOU CAN! and YOU CAN marks emanate from or are developed by a physician licensed to practice medicine in the United States, when in actuality they do not emanate from such a source. Therefore, the Opposer is using the asserted marks unlawfully and is coming into this proceeding with unclean hands.

Finally, Applicant intends to rely upon any other affirmative defense that it may discover during the discovery period and throughout this proceeding and, therefore, hereby reserves its right to amend these Affirmative Defenses.

WHEREFORE, having fully answered the Opposition, Applicant requests that a decision be entered against the Opposer and in favor of the Applicant, dismissing this Opposition with prejudice, granting registration upon the Principal Register to Applicant's YES YOU CAN! trademark applications Serial No.s 85/769860, 85/769864, and 85/769870, and granting such other and further relief as may be deemed proper.

### AMENDED COUNTERCLAIM

Applicant, CHABAN WELLNESS LLC, hereby counterclaims against Opposer MATTHIAS RATH ("Rath"), to cancel the Opposer's pleaded Registrations No. 2,863,920 and No. 3,967,892 pursuant to Trademark Rule 2.106(b)(2)(i). In support of the Counterclaim, Applicant alleges the following grounds:



### **General Background Allegations**

1. On December 1, 1999, under Serial No. 75861707, Rath filed an application with the USPTO to register the YOU CAN standard character mark in International Classes 5, 16, 31, 41 and 42 (the ‘707 Application).

2. On December 1, 1999, Rath also filed an application, under Serial No. 75862043, to register the YOU CAN! mark in stylized form in International Classes 5, 16, 31, 41 and 42 (the ‘043 Application).

3. On July 6, 2010, Rath filed a third application, under the Serial No. 85078752 and pursuant to Section 1B of the Lanham Act, to register the YOU CAN standard character mark in International Classes 5, 16, 41 and 44 (the ‘752 Application).

4. All three of these applications by Rath covered the same goods and services, and all three applications matured into trademark registrations upon the USPTO Principal Register. However, as described below, one has since been cancelled.

5. On August 5, 2003, the ‘707 Application matured into Registration No. 2,745,578 for the YOU CAN standard character mark pursuant to a claimed basis under Section 44(e) (hereinafter, the ‘578 Registration).<sup>3</sup> On May 7, 2010, the USPTO cancelled the ‘578 Registration as a result of Rath’s failure to file an acceptable Declaration of Use or Excusable Non-Use under Section 8 of the Lanham Act.

6. On July 20, 2004, Rath’s ‘043 Application matured into Registration No. 2,863,920 for the YOU CAN! mark in stylized form pursuant to a claimed basis under Section

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<sup>3</sup> The Opposer’s German trademark registration (No. 39959413) upon which the U.S. Registration No. 2,745,578 was based was cancelled on October 1, 2009 as a result of Matthias Rath’s failure to renew it.

44(e) (hereinafter, the ‘920 Registration).<sup>4</sup> On January 20, 2011, Rath filed a Declaration of Use under Section 8 of the Lanham Act and, as a result thereof, Rath’s ‘920 Registration is currently maintained upon the Principal Register for the following goods and services:

- a. In International Class 5: Nutritional supplements; dietary supplements; vitamin and mineral supplements;
- b. In International Class 16:
  - i. Newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements; and
  - ii. Educational materials, namely newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements;
- c. In International Class 41:
  - i. Educational services, namely, conducting instruction in the form of classes, seminars, workshops, and conducting continuing education courses in the field of healthcare and nutritional supplements; and
  - ii. Distributing course material in connection with the aforementioned educational services; and
- d. In International Class 42: Providing health information, namely, information in the field of healthcare and nutritional supplements, dietary supplements, vitamin and mineral supplements.

7. On May 24, 2011, Rath’s ‘752 Application matured into Registration No. 3,967,892 for the YOU CAN standard character mark based upon a first-use-in-commerce date of January 20, 2011 in Classes 5, 16 and 41, and upon a first-use-in-commerce date of January 1, 2011 in Class 44 (hereinafter, the ‘892 Registration). The ‘892 Registration is still maintained upon the Principal Register of the USPTO for the following goods and services:

- a. In International Class 5: Nutritional supplements; dietary supplements; vitamin and mineral supplements;
- b. In International Class 16:

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<sup>4</sup> The Opposer’s German trademark registration (No. 39959414) upon which the U.S. Registration No. 2,863,920 was based was cancelled on October 1, 2009 as a result of Matthias Rath’s failure to renew it.

- i. Newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements; and
  - ii. Educational materials, namely newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements;
- c. In International Class 41:
  - i. Educational services, namely, conducting instruction in the form of classes, seminars, workshops, and conducting continuing education courses in the field of healthcare and nutritional supplements; and
  - ii. Distributing course material in connection with the aforementioned educational services; and
- d. In International Class 42: Providing health information, namely, information in the field of healthcare and nutritional supplements, dietary supplements, vitamin and mineral supplements.

**Rath's '920 Registration Was Void Ab Initio and, thus, Should be Cancelled**

8. After a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that, in obtaining the '920 Registration, Rath knowingly and impermissibly expanded its scope by registering the YOU CAN mark for goods and services between which there is no material difference in the kind of economic activity being conducted. In other words, there is not a sufficient separation between the goods and services allegedly offered and registered under the '920 Registration. For example, in Class 16, the Opposer registered YOU CAN for "newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements", while also contemporaneously registering YOU CAN in Class 42 for "providing health information, namely, information in the field of healthcare and nutritional supplements, dietary supplements, vitamin and mineral supplements." Similarly, in Class 41, the Opposer registered YOU CAN for "distributing course material" whereas in Class 16, the Opposer registered YOU CAN for "educational materials."

**Rath Abandoned the ‘920 Registration and, thus, It Should be Cancelled**

9. After a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that Rath abandoned the YOU CAN! mark registered under the ‘920 Registration.

10. It appears that Rath made no use of the YOU CAN! mark in connection with any goods or services for more than five consecutive years from the date the ‘920 Registration issued (July 20, 2004) and not until at least the date that six-month grace period for filing his Section 8 Declaration expired (January 20, 2011).

11. The documents publicly available further support a reasonable belief that Rath filed his Section 8 Declaration of Use at the expiration of the grace period (January 20, 2011) by using an improper specimen of use for the improper purpose of reserving an otherwise invalid trademark upon the Principal Register.

12. However, due to the Opposer’s failure to use the YOU CAN! mark within a reasonable time following registration, that mark had become and is abandoned for purposes of Section 45 of the Trademark Act.

**Rath’s ‘920 Registration Has Been Maintained As a Result of Fraud  
Upon the USPTO and, thus, Should be Cancelled.**

13. After a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that Rath committed fraud upon the USPTO with regard to maintaining his ‘920 Registration through knowing and material misrepresentations as to the use (or lack thereof) of the purported YOU CAN! mark.

14. It appears that Rath never used the YOU CAN! mark between the date of registration (July 20, 2004) and the date his initial Section 8 Declaration of Use or Excusable

Nonuse was due (July 20, 2010).<sup>5</sup>

15. It further appears that if Rath made any use of the YOU CAN! mark, it was not until the expiration of the grace period for filing his initial Section 8 Declaration of Use or Excusable Nonuse (January 20, 2011). Indeed, Rath has admitted that the first use of a YOU CAN mark without regard to stylistic features was not until January 20, 2011.<sup>6</sup>

16. Moreover, after a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that Rath knowingly filed improper specimens of use as to some or all of the goods and/or services associated with the '920 Registration and, therefore, knowingly mislead the USPTO into allowing Rath to maintain the '920 Registration upon the Principal Register. Indeed, it appears that the use of the purported YOU CAN! mark which Rath asserted in his January 20, 2011 Section 8 Declaration of Use was merely token use and was not use in a trademark sense.

17. For example, with regard to International Class 5 (for nutritional supplements; dietary supplements; vitamin and mineral supplements), the specimen Rath submitted with his Declaration was not a printout from a webpage associated with the "Product" tab/pages of <http://drrathvitamins.com> website but, rather, merely a printout of a webpage associated with the "Contact" tab of such website, displaying some entities' contact information. However, public archives show that the actual "Product" pages of the website, which informed consumers of the particular goods being offered, did not contain the purported YOU CAN! mark. Accordingly, it

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<sup>5</sup> Rath's German trademark registration (No. 39959414) upon which the '920 Registration was based was cancelled on October 1, 2009 as a result of Rath's failure to renew it.

<sup>6</sup> Moreover, on March 7, 2010, the USPTO cancelled Rath's previous registration (the '578 Registration) for the YOU CAN mark in the same international classes as the Registrations he asserts in these proceedings because Rath failed to file a Section 8 Declaration of Use. Similarly, Rath's German trademark registration (No. 39959413) upon which the '578 Registration was based, was cancelled on October 1, 2009 as a result of Rath's failure to renew it.

appears that Rath knowingly filed improper specimens of use as to some or all of the goods and/or services associated with the purported YOU CAN mark and, therefore, knowingly mislead the USPTO into maintaining the '920 Registration upon the Principal Register.

18. Furthermore, it appears that Rath impermissibly expanded the scope of the '920 Registration by registering the YOU CAN mark for goods and services between which there is no material difference in the kind of economic activity being conducted. In other words, there is not a sufficient separation between the goods and services allegedly offered and registered under '920 Registration. For example, in Class 16, the Opposer registered YOU CAN for "newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements", while also contemporaneously registering YOU CAN in Class 42 for "providing health information, namely, information in the field of healthcare and nutritional supplements, dietary supplements, vitamin and mineral supplements." Similarly, in Class 41, the Opposer registered YOU CAN for "distributing course material" whereas in Class 16, the Opposer registered YOU CAN for "educational materials."

**Rath's '892 Registration Was Void Ab Initio and, thus, Should Be Cancelled**

19. After a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that Rath's '892 Registration was void ab initio and, thus, was never entitled to registration on the Principal Register and, consequently, should be cancelled therefrom.

20. The mark registered under the '892 Registration is, in all material respects and commercial impression, the same as a mark that Rath first registered under the cancelled '578 Registration which covered the same international classes as those covered by the '892 Registration. The mark registered under the '892 Registration is also the same, in all

material respects and commercial impression, as the mark registered under the '920 Registration. Accordingly, the '892 Registration is an improper duplication two previously registered marks.

21. Moreover, Rath has stated that his first use of the YOU CAN mark without regard to stylistic features was on January 20, 2011. However, it appears that the use of the purported YOU CAN mark which Rath asserted was merely token use and was not use in a trademark sense.

22. For example, with regard to International Class 5 (for nutritional supplements; dietary supplements; vitamin and mineral supplements), the specimen that Rath submitted on March 29, 2011 with his Statement of Use was not a printout from a webpage associated with the "Product" tab/pages of <http://drrathvitamins.com> website but, rather, merely a printout of a webpage associated with the "Contact" tab of such website, displaying some entities' contact information. According to public archives, the actual "Product" pages of the website, which informed consumers of the particular goods being offered, did not contain the purported YOU CAN mark.

23. Furthermore, it appears that Rath impermissibly expanded the scope of the '892 Registration by registering the YOU CAN mark for goods and services between which there is no material difference in the kind of economic activity being conducted. In other words, there is not a sufficient separation between the goods and services allegedly offered and registered under the '892 Registration. For example, in Class 16, Rath registered YOU CAN for "newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements", while also contemporaneously registering YOU CAN in Class 44 for "providing health information, namely, information in the field of healthcare and nutritional supplements, dietary supplements, vitamin and mineral supplements." Similarly, in Class 41,

Rath registered YOU CAN for “distributing course material” whereas in Class 16, Rath registered YOU CAN for “educational materials.”

**Rath’s ‘892 Registration Was Obtained As a Result of Fraud  
Upon the USPTO and, thus, Should be Cancelled.**

24. After a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that Rath committed fraud upon the USPTO with regard to obtaining his ‘892 Registration through knowing and material misrepresentations as to the purported YOU CAN mark.

25. The mark registered under the ‘892 Registration is, in all material respects and commercial impression, the same as the mark first registered under the cancelled ‘578 Registration which covered the same international classes as those covered under the ‘892 Registration. The mark registered under the ‘892 Registration is also the same, in all material respects and commercial impression, as the mark registered under the ‘920 Registration. Accordingly, the ‘892 Registration is an improper duplication two previously registered marks.

26. Moreover, Rath stated that his first use of the YOU CAN mark without regard to stylistic features was on January 20, 2011. However, it appears that the use of the purported YOU CAN mark which Rath asserted was merely token use and was not use in a trademark sense. For example, with regard to International Class 5 (for nutritional supplements; dietary supplements; vitamin and mineral supplements), the specimen Rath submitted on March 29, 2011 with his Statement of Use was not a printout from a webpage associated with the “Product” tab/pages of <http://drrathvitamins.com> website but, rather, merely a printout of a webpage associated with the “Contact” tab of such website, displaying some entities’ contact information. According to public archives, the actual “Product” pages of the website, which informed consumers of the particular goods being offered, did not contain the purported YOU



CAN mark. Accordingly, it appears that Rath knowingly filed improper specimens of use as to some or all of the goods and/or services associated with the purported YOU CAN mark and, therefore, knowingly mislead the USPTO into issuing the ‘892 Registration.

27. Furthermore, it appears that Rath knowingly and impermissibly expanded the scope of the ‘892 Registration by registering the YOU CAN mark for goods and services between which there is no material difference in the kind of economic activity being conducted. In other words, there is not a sufficient separation between the goods and services allegedly offered and registered under the ‘892 Registration. For example, in Class 16, Rath registered YOU CAN for “newspapers in the field of healthcare, nutritional supplements, dietary supplements, vitamin and mineral supplements”, while also contemporaneously registering YOU CAN in Class 44 for “providing health information, namely, information in the field of healthcare and nutritional supplements, dietary supplements, vitamin and mineral supplements.” Similarly, in Class 41, Rath registered YOU CAN for “distributing course material” whereas in Class 16, he registered YOU CAN for “educational materials.”

**Both the ‘920 and the ‘892 Registrations Should Be Cancelled  
Because Rath Is Using Them to Mislead Consumers**

28. After a reasonable investigation based upon information publicly available prior to the commencement of discovery, the Applicant reasonably believes that Rath is using the marks associated with the ‘920 Registration and the ‘892 Registration to mislead consumers into believing that the goods and services being sold in connection with the YOU CAN! and YOU CAN marks emanate from or are developed by a physician licensed to practice medicine in the United States, when in actuality they do not emanate from such a source.

29. For example, public archives of the website(s) shown in Rath’s specimens of use also show advertising statements such as: “Matthias Rath, M.D. is a world renowned physician

and scientist who led the breakthrough in the area of vitamins and cardiovascular health.” The advertisement also refers to Rath’s work on the “natural reversal of cardiovascular disease.” These advertisements describing Rath as a physician also repeatedly refer to Rath as “Dr. Rath.”

30. On August 28, 2002, the Food and Drug Administration’s Director of the Division of Compliance and Enforcement, Office of Nutritional Products, Labeling and Dietary Supplements issued a letter to Rath (the “FDA Letter”) advising him that the FDA had reviewed his website and found that he was improperly marketing products using therapeutic claims, establishing that they are drugs for the cure, mitigation, treatment or prevention of disease. The FDA Letter advised Rath that such marketing violates the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 321(g)(1)).

31. Given that Rath is using the YOU CAN and YOU CAN! marks to mislead consumers into believing that the goods and services being sold thereunder emanate from or are developed by a physician licensed to practice medicine in the United States, when in actuality they do not emanate from such a source, Rath is using the asserted marks unlawfully and, thus, the ‘920 Registration and the ‘892 Registration should be cancelled from the Principal Register.

**Both the ‘920 and the ‘892 Registrations Should Be Cancelled  
As a Result of Uncontrolled (*i.e.*, Naked) Licensing**

32. Public records and public archives indicate that Rath has used a web of several U.S. and international companies to advertise the marks and/or offer goods or services under the marks without any actual control over such activity or the quality thereof.

33. Thus, even if Rath had at one time possessed valid trademark registrations under the ‘920 Registration and the ‘892 Registration, it appears that Rath has engaged in uncontrolled licensing (“naked licensing”) of its alleged trademarks and, thus, has involuntarily abandoned

and/or lost his trademark rights with respect to those marks —*i.e.*, through the failure to exercise control over its licensees' use of the alleged trademark.

**WHEREFORE**, Applicant prays that RATH's trademark Registration No. 2,863,920 and No. 3,967,892 be cancelled from the United States Patent and Trademark Office's register of trademarks and RATH's Oppositions to the Applicant's trademark applications Serial No.s 85/769860, 85/769864, and 85/769870 be dismissed with prejudice.

Dated: February 5, 2014

Respectfully submitted,

/s/ Susan J. Latham

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**CERTIFICATE OF MAIL AND CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that, on February 5, 2014, this paper is being electronically filed via the Electronic System for Trademark Trial and Appeals. I also hereby certify that a true copy of the foregoing document was served on counsel for the Opposer by delivering the same via electronic mail (e-mail) to [jblattner@dickinsonwright.com](mailto:jblattner@dickinsonwright.com); [apelker@dickinsonwright.com](mailto:apelker@dickinsonwright.com), and by also delivering it via first class U.S. mail, postage prepaid, to: John C. Blattner, DICKINSON WRIGHT PLLC, 350 S. Main Street, Suite 300, Ann Arbor, Michigan 48104.

/s Susan J. Latham  
Susan J. Latham